

THIS DISPOSITION IS NOT  
CITABLE AS PRECEDENT OF THE TTAB MARCH 22, 00

U.S. DEPARTMENT OF COMMERCE  
PATENT AND TRADEMARK OFFICE

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Trademark Trial and Appeal Board

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In re Old Mexico Brand, Inc.

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Serial No. 75/237,873

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Daniel D. Chapman of Miller, Sisson, Chapman & Nash for  
applicant.

Montia O. Givens, Trademark Examining Attorney, Law Office  
111 (Craig D. Taylor, Managing Attorney).

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Before Hanak, Hairston and Walters, Administrative  
Trademark Judges.

Opinion by Walters, Administrative Trademark Judge:

Old Mexico Brand, Inc. has filed a trademark  
application to register the mark shown below for "prepared  
Mexican entrees consisting primarily of enchiladas made  
with beef and/or chicken and enchilada and tamale dinners  
made with chicken, beef and meat filling for tacos."<sup>1</sup>

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<sup>1</sup> Serial No. 75/237,873, in International Class 29, filed February 7,  
1997, based on an allegation of a bona fide intention to use the mark  
in commerce. The application includes the statement that the stippling  
is a feature of the mark and is not intended to indicate color.



The Trademark Examining Attorney has finally refused registration under Section 2(d) of the Trademark Act, 15 U.S.C. 1052(d), on the ground that applicant's mark so resembles the previously registered mark OLD MEXICO for "tortillas"<sup>2</sup> that, if used on or in connection with applicant's goods, it would be likely to cause confusion or mistake or to deceive.

Applicant has appealed. Both applicant and the Examining Attorney have filed briefs, but an oral hearing was not requested. We affirm the refusal to register.

Our determination under Section 2(d) is based on an analysis of all of the probative facts in evidence that are

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<sup>2</sup> Registration No. 1,558,319, issued January 30, 1989, in International Class 30, to La Favorita, Inc. (Affidavits under Sections 8 and 15 of the Trademark Act accepted and acknowledged, respectively.) The registration includes a disclaimer of MEXICO apart from the mark as a whole.

relevant to the factors bearing on the likelihood of confusion issue. See, *In re E. I. du Pont de Nemours and Co.*, 476 F.2d 1357, 177 USPQ 563 (CCPA 1973). In the analysis of likelihood of confusion in this case, two key considerations are the similarities or dissimilarities between the marks and the similarities or dissimilarities between the goods. *Federated Foods, Inc. v. Fort Howard Paper Co.*, 544 F.2d 1098, 192 USPQ 24, 29 (CCPA 1976).

We turn, first, to a determination of whether applicant's mark and the registered mark, when viewed in their entirety, are similar in terms of appearance, sound, connotation or commercial impression. The test is not whether applicant's mark can be distinguished from registrant's mark when subjected to a side-by-side comparison, but rather whether the marks are sufficiently similar in terms of their overall commercial impression that confusion as to the source of the goods offered under the respective marks is likely to result. The focus is on the recollection of the average purchaser, who normally retains a general rather than a specific impression of trademarks. See, *Sealed Air Corp. v. Scott Paper Co.*, 190 USPQ 106 (TTAB 1975). Furthermore, although the marks at issue must be considered in their entirety, it is well settled that one feature of a mark may be more significant

than another, and it is not improper to give more weight to this dominant feature in determining the commercial impression created by the mark. *See, In re National Data Corp.*, 753 F.2d 1056, 224 USPQ 749 (Fed. Cir. 1985).

The OLD MEXICO portion of applicant's mark is identical to registrant's mark in its entirety. Contrary to applicant's contentions, we find that the OLD MEXICO portion of applicant's mark is the dominant portion of the mark.<sup>3</sup> The term KITCHENS is significantly smaller than, and centered below, the term OLD MEXICO, which appears in bold print and is centered both over the starburst design and in the shield-like frame that comprises the border of the mark. Neither the border nor the starburst design is particularly unique and, in fact, each serves to highlight the term OLD MEXICO. Further, with regard to these design elements, where both words and a design comprise a mark, the words are normally accorded greater weight because the words are likely to make an impression upon purchasers that would be remembered by them and would be used by them to request the goods. *In re Appetito Provisions Co.*, 3 USPQ2d

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<sup>3</sup> The third-party registrations submitted by applicant with its brief are untimely and have been objected to by the Examining Attorney on that ground. Thus, we have given the submission no consideration. Even if applicant had established that the registered mark is weak, which it has not, as the Examining Attorney correctly noted, even weak marks are entitled to protection against a likelihood of confusion.

1553, 1554 (TTAB 1987); and *Kabushiki Kaisha Hattori Tokeiten v. Scuotto*, 228 USPQ 461, 462 (TTAB 1985). See also: *Giant Food, Inc. v. Nation's Food Service, Inc.*, 710 F.2d 1565, 218 USPQ 390 (Fed. Cir. 1983).

Thus, we find that, considered in their entirety, the commercial impressions of applicant's and registrant's marks are significantly similar.

We consider, next, the respective goods of applicant and registrant. It is quite true that the goods of applicant and registrant are different. However, it is well-settled that the goods of an applicant and registrant need not be similar or even competitive in order to support a holding of likelihood of confusion, it being sufficient for the purpose if such goods are related in some manner and/or if the circumstances surrounding their marketing are such that they would be likely to be encountered by the same persons under conditions that would give rise, because of the marks used thereon, to the mistaken belief that they emanate from or are in some way associated with the same source. See, *In re Kangeroos U.S.A.*, 223 USPQ 1025, 1026-1027 (TTAB 1984), and cases cited therein.

It is clear from the record and applicant's identification of goods that there is a type of food referred to as "Mexican" food; and that Mexican food

includes enchiladas, tamales, tacos and tortillas, all of which may contain meat fillings. The Examining Attorney submitted excerpts of articles from the LEXIS/NEXIS database about foods and restaurants. These articles contain many references to both tortillas and tacos. Additionally, the Examining Attorney submitted copies of third-party registrations wherein the identifications of goods include both prepared entrees and individual food items, including tortillas, meats, tacos and other components of applicant's entrees. Although these registrations are not evidence that the marks shown therein are in use or that the public is familiar with them, they nevertheless have some probative value to the extent that they serve to suggest that the goods listed therein are of a kind which may emanate from a single source. See *In re Albert Trostel & Sons Co.*, 29 USPQ2d 1783 (TTAB 1993); and *In re Mucky Duck Mustard Co. Inc.*, 6 USPQ2d 1467 (TTAB 1988).

We find that the goods of applicant and registrant are sufficiently related that, if identified by substantially similar marks, confusion would be likely.<sup>4</sup> This evidence is

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<sup>4</sup> However, we expressly reject the Examining Attorney's contention that "the goods are related because all are Mexican foods." Clearly, goods are not related simply because they are in the same general "field." There is no per se rule in this regard; rather, each case must be determined on the facts therein.

not overcome by applicant's declaration from a CEO of a sausage and processed meat manufacturer and distributor to the effect that the goods identified in this application and registrant's goods are different, for the reasons stated therein, and are sold in different parts of food stores.

Therefore, we conclude that in view of the substantial similarity in the commercial impressions of applicant's mark and registrant's mark, their contemporaneous use on the related goods involved in this case is likely to cause confusion as to the source or sponsorship of such goods. Consumers familiar with registrant's marks for the identified goods are likely to believe that applicant's goods are a related line of prepared entrees sponsored by registrant, or vice versa.

Serial No. 75/237,873

*Decision:* The refusal under Section 2(d) of the Act  
is affirmed.

E. W. Hanak

P. T. Hairston

C. E. Walters  
Administrative Trademark Judges,  
Trademark Trial and Appeal Board